

REMARKSStatus of Claims

Claims 1-21 are pending in the instant application. Claims 1-21 stand rejected. Favorable reconsideration is respectfully requested in light of the following remarks.

Rejection of Claims 1, 11, 18 and 20 under 35 USC §112

Claims 1, 11, 18 and 20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claims 1, 11 and 18 to designate the units as "percent by weight". No new matter has been added and support for these amendments can be found in the specification at page 8, Table 1.

Accordingly, Applicants respectfully submit that claims 1, 11 and 18 now comply with 35 U.S.C. §112, second paragraph, and respectfully request that the rejection be withdrawn.

Regarding claim 20, as calculated, there are no units for the components of the composition as the percentages refer to the solids content of dried coating. The formula that was used in determining this percentage is:

$$\% \text{ of dried coating} = \text{solids (lbs.)} / \text{total solids (lbs.)} \times 100$$

For example, in Table I, for GP 2925 the % of dried coating was determined as follows:

$$17.2\% = 75.76 \text{ lbs.} / 441.49 \text{ lbs.} \times 100$$

In this calculation, the units (lbs.) cancel each other out and the result is a percentage. Accordingly, Applicants respectfully submit that claim 20 complies with 35 U.S.C. 112, second paragraph, and respectfully request that the rejection be withdrawn.

Rejection of Claims 1-21 under 35 USC §103(a)

Claims 1-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kirchmeyer et al., (US 5,811,480).

The Office states that the prior art teaches of Kirchmeyer would have rendered obvious the invention as claimed. Applicants respectfully traverse this rejection.

Kirchmeyer et al. teach a size consisting essentially of

- a) polyepoxide, polyester, polyvinyl acetate or polyurethane film formers;
- b) organo-functional silanes;
- c) monomeric, aromatic di- or polycarboxylic acids;
- d) conventional size constituents, including emulsifiers, lubricants, wetting agents or anti-static agents;
- e) water.

In contrast, Applicants claim (in part, claim 1):

A sizing composition compatible with a phenolic pultrusion process comprising:  
a film forming polymer;  
a silane coupling agent;  
a non-ionic lubricant;  
a cationic lubricant; and  
a water dispersible polyether based polyurethane solution.

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations.

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The mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to modify the teachings of the references. See MPEP §2143.

Clearly, Kirchmeyer et al. does not teach or suggest all of Applicants' claim limitations, specifically a film forming polymer and a water dispersible polyether based polyurethane solution, as Applicants' claim. All claim limitations must be taught or suggested. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424, F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP 2143.03.

Independent claims 1, 11, 18 and 20 contain the limitations of "a water dispersible polyether based polyurethane solutions". Claims 2-10, 12-17, 19 and 21 ultimately depend from one of the aforementioned independent claims and contain the limitations thereof. Applicants respectfully submit that the criteria for establishing a *prima facie* case of obviousness have not been met and, as such, respectfully request that the 103(a) rejection of claims 1-21 be withdrawn.

### Conclusion

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the rejections is requested. Allowance of claims 1-21 at an early date is solicited.

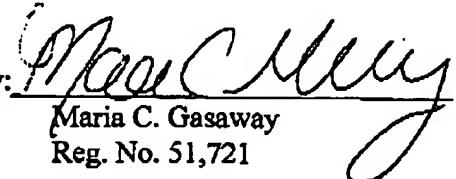
The Examiner is invited to telephone the Applicants' undersigned agent at (740) 321-7213 if any unresolved matters remain.

If any questions should arise with respect to the above Remarks, or if the Examiner has any comments or suggestions to place the claims in better condition for allowance, it is requested that the Examiner contact Applicants' agent at the number listed below.

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Applicant authorizes any fees required pertaining to this response be charged to Deposit Account No. 50-0568.

Respectfully submitted,

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